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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,107	11/25/2003	Miwa Kanamori	57810-083	4499

7590 03/05/2008
McDermott, Will & Emery
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

VUONG, QUOCHIE B

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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03/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,107

Applicant(s)

KANAMORI ET AL.

Examiner

Quochien B. Vuong

Art Unit

2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-26 is/are pending in the application.
- 4a) Of the above claim(s) 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/14/2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19, 21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofschen et al. (WO 99/00962 – English translation) in view of Saida Kazuo (Japanese Publication No. 06-334729 – machine English translation).

Regarding claim 19, Hofschen et al. discloses a portable telephone set (figure 1) comprising: talking portion (microphone and speakers); music replay portion (SPM), for superposing a talking voice of telephone communication on replayed portion when making the telephone communication through the talking portion during the music

replay by the music replay portion; and volume control portion for controlling the volume of the replayed music and the volume of the talking voice of the telephone communication; and the volume control portion includes a talking volume adjusting part, a music volume adjusting part and a control part controlling the talking volume adjusting part and the music volume adjusting part (the combined mobile phone with an audio unit (figure 2) comprising volume control portion (LSR) which can inherently control the volume of the replayed music and the volume of the telephone communication, see page 12, lines 15-21) (see abstract; and page 7, line 16 – page 10, line 5). Hofschien et al. do not specifically disclose the volume control portion mutually independently adjusting the talking volume and the music volume. However, Saida Kuzao (figure 2) disclose in a system in which a plurality of types of acoustic data are mixed and output, the volume of one of the plurality of types of acoustic data is set independently from the volume of the other (see paragraph [0027]). Therefore, it would have been obvious for one having ordinary skill in the art to adapt the teaching of Saida Kuzao to the portable telephone set of Hofschien et al. in order to separately set the talking volume and the music volume independent from each other as desired by the user

Regarding claim 21, Hofschien et al. and Saida Kuzao disclose the portable telephone set capable of arbitrarily setting the volume of the talking voice of the telephone communication and the volume of the replayed music in the process of the music replay (see Hofschien et al. page 9, lines 1-12; and page 10, lines 1-5; and Saida Kuzao, paragraph [0027]).

Regarding claim 26, Hofschen et al. further disclose wherein the volume control portion reduces the volume of the replayed music when superposing the talking voice of the telephone communication on the replayed music in the process of music replay (page 9, line1 1-12; and page 10, lines 1-5).

4. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofschen et al. in view of Saida Kuzao and further in view of Chin (US 5,661,788).

Regarding claim 20, Hofschen et al. and Saida Kuzao disclose the portable telephone set according to claim 19. Hofschen et al. and Saida Kazuo do not disclose telephone number storage portion storing telephone numbers, and superposing the talking voice of the telephone communication on the replayed music in the process of the music replay by the music replay portion when making the telephone communication with the telephone numbers stored in the telephone number storage portion. However, Chin (figure 1) discloses telephone number storage portion storing telephone numbers (figure 1, item 112) for selectively alerting the user of preferred telephone calls (see abstract, column 2, line 45 – column 3, line 3). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the telephone number storage portion and the teaching of Chin to the portable telephone set of Hofschen et al. and Saida Kazuo in such a way the portable telephone set superposing the talking voice of the telephone communication on the replayed music in the process of the music replay by the music replay portion when making the telephone communication with the telephone numbers stored in the

Art Unit: 2618

telephone number storage portion so that the user can be selectively alerted of the preferred incoming telephone calls as suggested by Chin (column 1, lines 50-53).

Regarding claim 22, Hofschien et al., Saida Kazuo, and Chin disclose the portable telephone set of claim 20 above; in addition, Hofschien et al. disclose the portable telephone set capable of arbitrarily setting the volume of the talking voice of the telephone communication and the volume of the replayed music in the process of the music replay in correspondence to the telephone number stored in the telephone number storage portion (page 9, lines 1-12; and page 10, lines 1-5).

Response to Arguments

5. Applicant's arguments with respect to claims 19-22 and 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B. Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



QUOCHIE B. VUONG
PRIMARY EXAMINER

Quochien B. Vuong
Mar. 03, 2008.